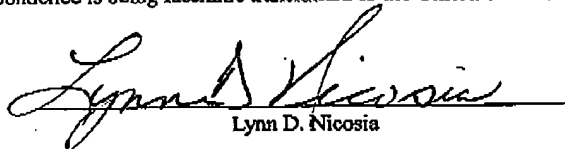


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Lynn D. Nicosia

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| APPEAL BRIEF | | | Docket No. EDD002USPT01 |
| Serial No. 10/033,580 | Filing Date December 28, 2001 | Examiner Marsh, Steven M. | Group Art Unit 3632 |
| Applicant: | Eddy | | |
| Invention: | EAVES TROUGH SUPPORT BRACKET | | |

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is filed on appeal from the decision of the Examiner dated November 30, 2004 reopening prosecution of this application after Applicant's filing of an Appeal Brief and rejecting claims 1, 3-16 and 18-22 in the above-referenced patent application.

Applicant requests reinstatement of the appeal.

REAL PARTY IN INTEREST

The real party in interest in connection with this appeal is the inventor Gary Eddy.

RELATED APPEALS AND INTERFERENCES

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

The application was filed on December 28, 2001 with claims 1-20. Claims 1, 18 and 19 were amended, claims 2 and 17 canceled and new claims 21 and 22 added in an Amendment and Response filed on December 19, 2002. Claims 1, 7, 13, 18 and 19 were amended in an Amendment and Response filed on August 26, 2003 concomitantly with the filing of a RCE. Claim 22 was amended in an Amendment and Response filed on December 12, 2003. Claims 1, 3-16 and 18-22 remain pending in the application. Claims 1, 3-16 and 18-22 have been finally rejected. No claims have been allowed.

The rejection of claims 1, 3-16 and 18-22 is appealed. A copy of the claims involved in this appeal was provided in the Appendix section of the Appeal Brief.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection of the appealed claims.

SUMMARY OF CLAIMED SUBJECT MATTER

A **First Embodiment** of the present claimed invention (claims 1 and 3-16) is directed to an eaves trough support bracket [10] having a first leg [110] extending in a second transverse direction [z^2] from the first edge [23] of a main beam [20] with a proximal longitudinal end [111] substantially transversely aligned with a proximal end [21] of the main beam [20] and a second leg [120] extending in the second transverse direction [z^2] from a second edge [24] of the main beam [20] with a proximal longitudinal end [121] substantially transversely aligned with the

proximal end [21] of the main beam [20]. [Page 8, Lines 31-36]. The main beam [20], first leg [110], and second leg [120] define a concavity accessible from a first transverse direction [z^1] whereby the support bracket [10] is transversely nestable. [Figures 1-4]. A connection element [30] extends in the first transverse direction [z^1] from the distal end [22] of the main beam [20] with a longitudinally extending tab [50] transversely spaced from the main beam [20] in the first transverse direction [z^1] a distance of about 0.4 to 0.6 inches from a first surface [25] of the main beam [20]. [Page 6, Line 31 through Page 7, Line 3 and Page 7, Lines 11-12]. A hook [60] extends in the first transverse direction [z^1] and a second longitudinal direction [x^2] from the proximal end [21] of the main beam [20] and defines a concavity [69] open in the second transverse direction [z^2]. [Page 7, Lines 20-22].

A Second Embodiment of the present claimed invention (claim 18) is directed to an article of commerce including a length of eaves trough [400] and a plurality of the eaves trough support brackets [10] of the First Embodiment. [Page 2, Lines 27-29].

A Third Embodiment of the present claimed invention (claims 19 and 20) is directed to a method of installing the article of commerce of the Second Embodiment, including the steps of (i) engaging the connection element [30] of the support bracket [10] within a snap-lock channel [440] formed in the eaves trough [400], (ii) sliding a distal edge [422] of the rear wall [420] of the eaves trough [400] into the concavity [69] defined by the hook [60] to form a connected eaves trough assembly, (iii) positioning the connected eaves trough assembly along an eave [500] with the back wall [420] of the eaves trough [400] engaging the eave [500], and (iv) securing the connected eaves trough assembly to the eave [500] by longitudinally driving a mechanical fastener [300] through the hook [60] of the bracket [10] and the rear wall [420] of the eaves trough [400], and into connective engagement with the eave [500]. [Page 10, Line 32 through Page 11, line 14].

A Fourth Embodiment of the present claimed invention (claim 21) is directed to an eaves trough support bracket [10] having a main beam [20], first leg [110] and second leg [120]. [Page 6, Lines 3-5]. The first leg [110] and second leg [120] extend in a second transverse direction [z^2]. [Page 8, Lines 31-31]. The first leg [110] has a transverse height that tapers in the

second transverse direction $[z^2]$ with a height at the longitudinal center of the main beam [20] less than one half the transverse height at the proximal longitudinal end [111] of the first leg [110]. [Figures 2, 3 and 5]. The second leg [120] has a transverse height that tapers in the second transverse direction $[z^2]$ with a height at the longitudinal center of the main beam [20] less than one half the transverse height at the proximal longitudinal end [121] of the second leg [120]. [Figures 2, 3 and 5].

A Fifth Embodiment of the present claimed invention (claim 22) is directed to an eaves trough support bracket [10] having a main beam [20], connection element [30], first leg [110], second leg [120], a first bend line [201], second bend line [202], at least one primary rib [131], and at least one secondary rib [132]. [Page 6, Lines 3-5 and Page 9, Lines 29-32]. The connection element [30] includes a strut [40] and a tab [50]. [Page 6, Line 31]. The at least one primary rib [131] is formed within the main beam [20] and the strut [40] which extends across and substantially perpendicular to the first bend line [201] and overlaps the first leg [110] and second leg [120] improving the strength of the bracket [10]. [Page 9, Lines 29-32 and Figures 2 and 3]. The at least one secondary rib [132] is formed within the strut [40] and the tab [50] and extends across and substantially perpendicular to the second bend line [202] and transversely overlaps the at least one primary rib [131] improving the strength of the bracket [10]. [Page 9, Lines 29-32 and Figures 2 and 3].

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 3-16 and 18-20 fail to comply with 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".
2. Whether claim 22 is indefinite for failing to show overlapping of the primary rib and the legs.
3. Whether claims 1, 3-16 and 18-22 are obvious over Odekirk (United States Patent No. 4,294,422).

ARGUMENT***Objections/Rejections
Under 35 U.S.C. § 112***

1.0 *The Examiner has rejected claims 1, 3-16 and 18-20 as non-enabled under ¶1.*

The First, Second and Third Embodiments of the present claimed invention are directed to eaves trough support brackets, a combination of eaves trough with such brackets and installation of such a combination, where the eaves trough support bracket includes a main beam, a first leg, and a second leg defining a concavity accessible from the first transverse direction rendering the bracket transversely nestable. Support for the claimed invention is found in Figures 1-4. Persons skilled in the art would know and understand that the invention as shown and described in the specification is nestable by considering the size, shape and configuration of the main beam, first leg, and second leg. While the Figures and written description do not expressly illustrate or describe the brackets in a nested configuration, Figures 1-4 clearly illustrate a bracket with the inherent function of nestability. Therefore, the function of nestability is inherently disclosed in the specification and recitation of this inherent function in the claims does not introduce new matter. See, M.P.E.P. §2163.07(a) [INHERENT FUNCTION, THEORY OR ADVANTAGE].

2.0 *The Examiner has objected to claim 22 as indefinite for failing to show overlapping of the primary rib and the legs.*

Applicant respectfully disagrees that claim 22 is indefinite. Claim 22 recites "at least one primary rib formed within the main beam and the strut which ... (ii) *longitudinally* overlaps the first leg and the second leg ..." (Emphasis Added). Figures 1-4 and 5 support this claimed element. Referring to Figure 2, the rib (131) clearly longitudinally overlaps the first leg (110) as the rib (131) has a longitudinal length that starts proximate the strut (40) and the distal longitudinal end (112) of the first leg (110) and runs in the second longitudinal direction (x^2) toward the proximal longitudinal end (111) of the first leg (110). Hence, the rib longitudinally overlaps the first leg.

Objections/Rejections
Under 35 U.S.C. §103

3.0 *The Examiner has rejected claims 1, 3-16 and 18-22 as obvious over Odekirk (United States Patent No. 4,294,422).*

SUMMARY OF CITED REFERENCES

Odekirk discloses an eaves trough support bracket comprising a longitudinally elongated main beam, a first longitudinally elongated side rib extending along a first side of the main beam, and a second longitudinally elongated side rib extending along a second side of the main beam. A connection element comprising a strut [62] and a tab [60] is provided at the longitudinal distal end of the main beam for attaching the bracket to channel on the forward face of a gutter. The strut extends upward from the main beam while the tab extends longitudinally from the strut. A clip [70] is provided at the longitudinal proximal end of the main beam for sliding engagement over the back sidewall of the gutter and accommodating passage of a nail through the clip and into a fascia board. The clip extends transversely above the top of the main beam and below the bottom of the side ribs. A rib is provided across the bend line between the main beam and the strut. The first and second side ribs extend from the main beam in a second transverse direction with the transverse height of the side ribs remaining substantially unchanged along the entire longitudinal length of the bracket.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

As to the first criteria, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. § 2143.01.

FIRST, SECOND AND THIRD EMBODIMENTS

(CLAIMS 1, 3-16 AND 18-20)

The First, Second and Third Embodiments of the present claimed invention (claims 1, 3-16 and 18-20) are directed to nestable eaves trough support brackets, a combination of eaves trough with such brackets and installation of such a combination. The eaves trough support bracket disclosed by Odekirk is NOT nestable. The combination of (i) an unnestable clip [70] at one end of the main beam which extends transversely above the main beam and below the side ribs, (ii) an unnestable transversely extending connection element [60 and 62] at the other end of the main beam, and (iii) side ribs which extend only a short distance from the main beam, renders the entire bracket unnestable.

FOURTH EMBODIMENT

(CLAIM 21)

The Fourth Embodiment of the present claimed invention is directed to an eaves trough support bracket having legs with a transversely tapered height with a height at the longitudinal center of the main beam which is less than one half the transverse height at the proximal longitudinal end of the first leg. Odekirk discloses a gutter bracket with legs having an extremely short and uniform transverse height along the entire length of the main beam.

FIFTH EMBODIMENT
(CLAIM 22)

The Fifth Embodiment of the present claimed invention is directed to a bracket with a primary rib which extends across and is substantially perpendicular to the bend line between the distal end of the main beam and the strut. The primary rib is configured and arranged so that the primary rib longitudinally overlaps the first and second legs so as to further improve the strength of the bracket. While the eaves trough support bracket disclosed by Odekirk also has a rib which extends across and is substantially perpendicular to the bend line between the distal end of the main beam and the strut, this rib does not longitudinally overlap the side ribs, as can clearly be seen in FIG 1.

CONCLUSION

Applicant respectfully submits that all pending claims (claims 1, 3-16 and 18-22) are in condition for allowance.

Respectfully submitted,

Date 30 July 05

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CLAIMS APPENDIX**PENDING CLAIMS**

*United States Patent Application
Serial No. 10/033,580*

1. An eaves trough support bracket, comprising:
 - (a) a main beam having longitudinally spaced distal and proximal ends, laterally spaced first and second edges, and transversely spaced first and second surfaces;
 - (b) a connection element extending in a first transverse direction from the distal end of the main beam and having a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam;
 - (c) a hook extending in the first transverse direction and a second longitudinal direction from the proximal end of the main beam, and defining a concavity open in a second transverse direction;
 - (d) a first leg extending in a second transverse direction from the first edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam; and
 - (e) a second leg extending in the second transverse direction from the second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam.
 - (f) wherein the main beam, first leg and second leg define a concavity accessible from the first transverse direction whereby the support bracket is transversely nestable.
3. The bracket of claim 1 comprising a laterally extending first bend line along a transition line from the main beam to the connection element.
4. The bracket of claim 3 further comprising at least one rib formed within the main beam and the connection element which extends across and substantially perpendicular to the first bend

line, whereby the longitudinal structural strength of the bracket along the first bend line is improved.

5. The bracket of claim 1 comprising a laterally extending second bend line along a transition line from the main beam to the hook.

6. The bracket of claim 5 further comprising at least one rib formed within the main beam and the hook which extends across and substantially perpendicular to the second bend line, whereby the longitudinal structural strength of the bracket along the second bend line is improved.

7. The bracket of claim 1 wherein the connection element includes (i) a strut with a first transverse end connected to the distal end of the main beam and a second transverse end extending in a first transverse direction from the distal end of the main beam, and (ii) the tab with a first longitudinal end connected to the second transverse end of the strut and a second transverse end extending in a second longitudinal direction from the second transverse end of the strut.

8. The bracket of claim 7 comprising a laterally extending third bend line along a transition line from the strut to the tab.

9. The bracket of claim 8 further comprising at least one rib formed within the strut and the tab which extends across and substantially perpendicular to the third bend line, whereby the longitudinal structural strength of the bracket along the third bend line is improved.

10. The bracket of claim 1 wherein the hook includes (i) a transversely extending shaft portion with a first end connected to the proximal end of the main beam and a second end extending in the first transverse direction from the proximal end of the main beam, (ii) a hooking portion with a first end connected to the second end of the shaft and a second end extending away from the distal end of the main beam in a second longitudinal direction from the second end of the shaft, and (iii) a transversely extending extension portion with a first end connected to the

second end of the hooking portion and a second end extending in the second transverse direction from the second end of the hooking portion.

11. The bracket of claim 1 further comprising a longitudinally extending fourth bend line along a transition line from the main beam to the first leg.

12. The bracket of claim 11 further comprising a longitudinally extending fifth bend line along a transition line from the main beam to the second leg.

13. The bracket of claim 10 further comprising a longitudinally aligned hole through each of the shaft and extension portions of the hook effective for accommodating partial passage of a mechanical fastener through the holes.

14. The bracket of claim 1 wherein the proximal longitudinal ends of the first and second legs independently have a transverse height of about 0.5 to 1.5 inches.

15. The bracket of claim 12 wherein (i) the fourth and fifth bend lines each have a distal longitudinal end proximate the distal end of the main beam, and (ii) at least one rib which extends across and is substantially perpendicular to the first bend line extends beyond the distal longitudinal ends of the fourth and fifth bend lines in the second transverse direction.

16. The bracket of claim 1 wherein the bracket is formed from a single unitary piece of metal.

18. An article of commerce, comprising:

- (a) a length of eaves trough; and
- (b) a plurality of eaves trough support brackets comprising:
 - (i) a main beam having longitudinally spaced distal and proximal ends, laterally spaced first and second edges, and transversely spaced first and second surfaces,
 - (ii) a connection element extending in a first transverse direction from the distal end of the main beam and having a longitudinally extending tab

- transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam,
- (iii) a hook extending in the first transverse direction and a second longitudinal direction from the proximal end of the main beam, and defining a concavity open in a second transverse direction,
 - (iv) a first leg extending in a second transverse direction from the first edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam, and
 - (v) a second leg extending in the second transverse direction from the second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam.
 - (vi) wherein the main beam, first leg and second leg define a concavity accessible from the first transverse direction whereby the support bracket is transversely nestable.
19. A method of installing eaves trough, comprising the steps of:
- (a) obtaining a length of eaves trough defining a water diversion channel and comprising:
 - (i) a bottom having longitudinally spaced and laterally extending first and second edges,
 - (ii) a back wall transversely extending from the second laterally extending edge of the bottom and having a laterally extending distal edge transversely spaced from the bottom in a primary transverse direction,
 - (iii) a front wall transversely extending from the first laterally extending edge of the bottom and having a laterally extending distal edge transversely spaced from the bottom in the primary transverse direction, and
 - (iv) a laterally extending snap-lock channel formed along the distal edge of the front wall
 - (b) obtaining a plurality of eaves trough support brackets comprising:

- (i) a main beam having longitudinally spaced distal and proximal ends, laterally spaced first and second edges, and transversely spaced first and second surfaces,
 - (ii) a connection element extending in a first transverse direction from the distal end of the main beam configured and arranged with a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam for releasable engagement within the snap-lock channel formed in the eaves trough,
 - (iii) a hook extending in the first transverse direction and a second longitudinal direction from the proximal end of the main beam, and defining a concavity open in a second transverse direction,
 - (iv) a first leg extending in a second transverse direction from the first edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam, and
 - (v) a second leg extending in the second transverse direction from the second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam,
 - (vi) wherein the main beam, first leg and second leg define a concavity accessible from the first transverse direction whereby the support bracket is transversely nestable;
- (c) engaging the connection element of the support bracket within the snap-lock channel formed in the eaves trough;
 - (d) sliding the distal edge of the rear wall of the eaves trough into the concavity defined by the hook to form a connected eaves trough assembly;
 - (e) positioning the connected eaves trough assembly along an eave with the back wall of the eaves trough engaging the eave; and
 - (f) securing the connected eaves trough assembly to the eave by longitudinally driving a mechanical fastener through the hook of the bracket and the rear wall of the eaves trough, and into connective engagement with the eave.

20. The method of claim 19 wherein the mechanical fastener passes through a hole in the hook and the hole is vertically positioned above the distal edge of the front wall of the eaves trough after installation of the eaves trough assembly such that water retained within the water diversion channel defined by the eaves trough will spill over the distal edge of the front wall of the eaves trough before contacting the hole in the hook.

21. An eaves trough support bracket, comprising:

- (a) a main beam having longitudinally spaced distal and proximal ends, laterally spaced first and second edges, and transversely spaced first and second surfaces;
- (b) a connection element extending in a first transverse direction from the distal end of the main beam;
- (c) a hook extending in the first transverse direction and a second longitudinal direction from the proximal end of the main beam, and defining a concavity open in a second transverse direction;
- (d) a first leg (i) extending in a second transverse direction from the first edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam, and (ii) having a transverse height that tapers in the second transverse direction with a transverse height at the longitudinal center of the main beam of less than one half the transverse height at the proximal longitudinal end of the first leg; and
- (e) a second leg (i) extending in the second transverse direction from the second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam, and (ii) having a transverse height that tapers in the second transverse direction with a transverse height at the longitudinal center of the main beam of less than one half the transverse height at the proximal longitudinal end of the second leg.

22. An eaves trough support bracket, comprising:

- (a) a main beam having longitudinally spaced distal and proximal ends, laterally spaced first and second edges, and transversely spaced first and second surfaces;

- (b) a connection element integrally formed with and extending in a first transverse direction from the distal end of the main beam wherein the connection element includes (i) a strut with a first transverse end connected to the distal end of the main beam and a second transverse end extending in a first transverse direction from the distal end of the main beam, and (ii) a tab with a first longitudinal end connected to the second transverse end of the strut and a second transverse end extending in a second longitudinal direction from the second transverse end of the strut;
- (c) a hook extending in the first transverse direction and a second longitudinal direction from the proximal end of the main beam, and defining a concavity open in a second transverse direction;
- (d) a first leg extending in a second transverse direction from the first edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam;
- (e) a second leg extending in the second transverse direction from the second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam;
- (f) a laterally extending first bend line along a transition line from the main beam to the strut;
- (g) at least one primary rib formed within the main beam and the strut which (i) extends across and substantially perpendicular to the first bend line, whereby the structural strength of the bracket along the first bend line is improved, and (ii) is latitudinally offset and longitudinally overlaps the first leg and the second leg, whereby the structural strength of the bracket along the first bend line is improved;
- (h) a laterally extending second bend line along a transition line from the strut to the tab; and
- (i) at least one secondary rib formed within the strut and the tab which (i) extends across and substantially perpendicular to the second bend line, whereby the structural strength of the bracket along the second bend line is improved, and (ii)

transversely overlaps the at least one primary rib whereby the strength of the bracket along the strut is improved.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE

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